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JOHN S. BEULICK  
C/O ARMSTRONG TEASDALE, LLP  
ONE METROPOLITAN SQUARE  
SUITE 2600  
ST LOUIS, MO 63102-2740

EXAMINER

BASHORE, ALAIN L

ART UNIT PAPER NUMBER

1762

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/681,408

Applicant(s)

CASCIANO, ANTHONY G.

Examiner

Alain L. Bashore

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2004 and 14 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27, 37-44 and 54-58 is/are pending in the application.
- 4a) Of the above claim(s) 1-6, 54-58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-27 and 37-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of claims 7-27 and 37-44 in the reply filed on 2-14-05 is acknowledged. The traversal is on the ground(s) that both groups are encompassed in a single class and single subclass and therefore are unsupportable for restriction. This is not found persuasive because the terms "workload driver" and "trigger level" may be entirely software, not hardware. The point of novelty for apparatus in class 705 cannot be relied entirely on a method limitation, unless a means-plus-function is claimed.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-6 and 54-58 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 2-14-05. The current office action has not been made final so that rejoinder is possible if means-plus-function language is made part of the claims withdrawn from consideration. A complete reply to a final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Claim Rejections - 35 USC § 112; first and second paragraph***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 7, 17, 37, 54 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant amended the claims 11-27-02 to define a workload driver as: "an element of the financing that will undergo an underwriting process as part of the financing evaluation".

This appears to be new matter not found in the originally filed specification. It is not clear what constitutes a "work load driver", or what its meets and bounds.

5. Claims 1, 6-27, 37-39, 54 and 56 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 6-21, 23, 37-39, 54 and 56 recite a "workload driver" which is considered vague and indefinite since it is not clear if this is hardware, software, or a concept per se. For the purpose of this examination a work load driver is considered a concept that acts on another concept.

### ***Specification***

6. The amendment filed 11-27-02 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "A deal is defined as any loan portfolios, leases, finances, and any other financial activity".

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Field in view of Chaudhuri et al (207) in further view of King.

Field discloses a method for facilitating use of a pricing model for evaluating a deal. Claims are entered (col 5, lines 30-50), where each claim is an element of the deal that is to be reviewed as part of collection statistics (deal evaluation). Trigger levels are entered for the claims where each level assigned indicates an anticipated level of effort to review the claims (col 20, lines 4-10). Expected collections are determined (col 5, lines 55-67).

Field does not disclose workload drivers.

Chaudhuri et al (207) discloses allocating workload drivers and trigger levels for a database (col 2, lines 14-67).

It would have been obvious to one with ordinary skill in the art to include allocating expenses based upon workload drivers and their trigger levels to Field because Chaudhuri et al (207) teaches workload database considerations is used to optimize database performance (col 1, lines 24-33).

Field and Chaudhuri et al (207) does not disclose a deal that includes a portfolio of loans and allocation of portfolio and underwriting expenses based upon workload drivers and corresponding triggers.

King discloses a deal that includes loans (col 1, lines 23-67) and allocation of portfolio and underwriting expenses corresponding to the loans (col 20, lines 19-22).

It would have been obvious to one with ordinary skill in the art to include to Field in view of Chaudhuri et al (207) a deal that includes a portfolio of loans and allocation of portfolio and underwriting expenses based upon workload drivers and corresponding triggers because King teaches that debt and equity instruments are utilized for transfer of funds (col 1, lines 30-38) and Field teaches on type of instrument (a claim pool).

It would have been obvious to one with ordinary skill in the art to include to Field in view of Chaudhuri et al (207) a deal that includes allocation of portfolio and underwriting expenses based upon workload drivers and corresponding triggers because King teaches expenses as a cost of doing business (col 20, line 19).

A "review" is considered broad enough to encompass advance rate change considerations described in the prior art.

It would have been obvious to one with ordinary skill in the art to include allocating portfolio and underwriting expenses based upon workload drivers and corresponding trigger levels because King teaches the importance of matching objectives of deals (col 6, lines 31-37).

The database art is considered within the purview of deal evaluation.

9. Claims 7 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Field in view of Chaudhuri et al (207).

Field discloses a method for facilitating use of a pricing model for evaluating a deal. Claims are entered (col 5, lines 30-50), where each claim is an element of the deal that is to be reviewed as part of collection statistics (deal evaluation). Trigger levels are entered for the claims where each level assigned indicates an anticipated level of effort to review the claims (col 20, lines 4-10). Expected collections are determined (col 5, lines 55-67).

Field does not disclose workload drivers.

Chaudhuri et al (207) discloses allocating workload drivers and trigger levels for a database (col 2, lines 14-67).

It would have been obvious to one with ordinary skill in the art to include allocating expenses based upon workload drivers and their trigger levels to Field because Chaudhuri et al (207) teaches workload database considerations is used to optimize database performance (col 1, lines 24-33).



10. Claims 8-16, 38-44 rejected under 35 U.S.C. 103(a) as being unpatentable over Field in view of Chaudhuri et al (207) in further view of King as applied to claims above, and further in view of Freeman et al.

Claims 8, 18-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Field in further view of Chaudhuri et al (207) as applied to claims 7 and 17 above, and further in view of Freeman et al.

Neither King, Field, or Chaudhuri et al (207) disclose the specific data recited in claims 6, 8-16, 18-27 and 38-44.

Freeman et al discloses financial data including loan data (col 8, lines 9-11, 39-45; col 13, lines 48-59).

It would have been obvious to one with ordinary skill in the art to include loan data and loan portfolios because Freeman et al teaches the importance of loan portfolio management ( col 1, lines 9-54).

***Response to Arguments***

11. Applicant's arguments filed 6-10-04 have been fully considered but they are not persuasive.

While the specification gives embodiments as to what a "workload driver" can be, there is no specific definition that would define the meets and bounds of such a term.

The sections of the specification do not appear to support the claim language added by amendment on 11-21-03.

A database access with workload of queries meets the definition of "workload driver" and "trigger levels" as currently maintained in the rejection of record.

***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alain L. Bashore whose telephone number is 571-272-6739. The examiner can normally be reached on about 7:30 am to 5:00 pm (Mon. thru Thurs.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Regarding all Class 705 applications, the management contact regarding examination is: Vincent Millin (SPE, art unit 3624) at 571-272-6747.

Art Unit: 1762

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alain L. Bashore  
Primary Examiner  
Art Unit 1762